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Application Serial No. 09/892,727
Attorney Docket No. 60027.0018USU1/BS01040

AUG 08 2006

REMARKS

This Amendment is in response to the Final Office Action dated February 8, 2006 (hereinafter the “*Action*”). Examination and reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1, 2, 4-10, 12-22, and 24-33 were pending in the application, of which Claims 1, 6, 20, 21, 25, and 26 are independent. Claims 1, 2, 4-10, 12-22, and 24-33 were rejected under 35 U.S.C. §103(a) and Claims 27 and 32 were rejected under 35 U.S.C. §112, first paragraph. Following this response, Claims 1, 2, 4-10, 12-22, and 24-33 remain in this application, with Claims 34 and 35 being added by this Amendment. Furthermore, the specification has been amended. Applicant hereby addresses the Examiner's rejections in turn.

Claim Rejections - 35 USC § 112

In the *Action* Claims 27 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The *Action* states:

The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 27 and 32 have been amended, and support for the amendment can be found in an amended paragraph submitted with this current Amendment and on page 5, lines 9-11 of Applicants' original disclosure. Applicants respectfully submit that the amendments overcome this rejection and add no new matter.

Claim Rejections - 35 USC § 103

Claims 1-2, 4-10, 12-22, and 24-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Middeke et al., U.S. Patent No. 6,445,907, (hereinafter “*Middeke*”), in view of Rangarajan, U.S. Patent No. 5,987,514 (hereinafter “*Rangarajan*”). Claims 1, 6, 20, 21, 25, and 26 have been amended, and Applicant respectfully submits that the amendments overcome this rejection and add no new matter.

Application Serial No. 09/892,727
Attorney Docket No. 60027.0018USU1/BS01040

Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. MPEP §2143; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996).

I. Independent Claims 1, 21, and 26

Applicants respectfully submit that the references used in the *Action* fail the third prong of obviousness in that, the cited references fail to teach or suggest all claim limitations. Amended Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, *inter alia*, "uploading a second diagnostic agent to the media delivery device, in response to a determination that the first diagnostic agent is not functional, wherein uploading the second diagnostic agent deletes the first diagnostic agent, thereby conserving memory resources." Amended Claims 21 and 26 includes a similar recitation.

In contrast, *Middeke* at least does not disclose the aforementioned recitation. Per the *Action's* admission, *Middeke* does not disclose uploading a second diagnostic agent to the media delivery device. (*See Action*, page 4, lines 1-3.) Consequently, Applicants respectfully submit that *Middeke* does not disclose uploading a second diagnostic agent to the media delivery device, in response to a determination that the first diagnostic agent is not functional, wherein uploading the second diagnostic agent replaces the first diagnostic agent, thereby conserving memory resources.

Furthermore, *Rangarajan* does not overcome *Middeke's* deficiencies. *Rangarajan* merely discloses sending a second event request which could be followed by a third event request and so on. (*See Rangarajan* col. 5, line 64 - col. 6, line 15.) An event request is not a diagnostic agent. An event request is a request that directs the mid-level manager to poll a device, i.e. the mid-level manager collects information from the device. (*See Rangarajan* col. 2, lines 24-27.) A diagnostic agent has to ability to autonomously, among other things, 1) perform various system diagnoses, 2) identify a problem, 3) indicating a failure to identify a problem, 4) attempt to remedy a malfunctioning device, and 5) identify the device upon which it is installed.

Application Serial No. 09/892,727
Attorney Docket No. 60027.0018USU1/BS01040

(*See Applicants' Disclosure* page 11, lines 16-25 and page 14, lines 24-25.) Therefore, sending an event request of *Ragarajan* is not the same as uploading a diagnostic agent as in Applicants' invention. Like *Middeke*, *Ragarajan* at least does not disclose uploading a second diagnostic agent to the media delivery device, in response to a determination that the first diagnostic agent is not functional, wherein uploading the second diagnostic agent replaces the first diagnostic agent, thereby conserving memory resources.

Combining *Middeke* with *Ragarajan* would not have led to the claimed invention because *Middeke* and *Ragarajan*, either individually or in any reasonable combination, at least do not disclose "uploading a second diagnostic agent to the media delivery device, in response to a determination that the first diagnostic agent is not functional, wherein uploading the second diagnostic agent deletes the first diagnostic agent, thereby conserving memory resources," as recited by amended Claim 1. Amended Claims 21 and 26 includes a similar recitation. MPEP §2143.03 citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) states that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested." In light of the above remarks, Applicants respectfully submit that the *Action* has failed the third prong of obviousness in that the cited references do not teach or suggest all the claim limitations. Accordingly, independent Claims 1, 21, and 26 each patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claims 1, 21, and 26.

Dependent Claims 2, 4, 5, 22, 24 and 27-35 are also allowable at least for the reasons described above regarding independent Claims 1, 21, and 26, and by virtue of their respective dependencies upon independent Claims 1, 21, and 26. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 1, 2, 4, 5, 21, 22, 24, and 26-35.

II. Independent Claims 6, 20, and 25

Independent Claims 6, 20, and 25 are system and/or apparatus claims which are "analyzed with respect to claim 1." (*See Action* page 5 and page 7.) Therefore, the remarks regarding independent Claim 1 apply. Accordingly, independent Claims 6, 20, and 25 each patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claims 6, 20, and 25.

Application Serial No. 09/892,727
Attorney Docket No. 60027.0018USU1/BS01040

Dependent Claims 7-10, and 12-19 are also allowable at least for the reasons described above regarding independent Claims 6, 20, and 25, and by virtue of their respective dependencies upon independent Claims 6, 20, and 25. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 6-10, 12-20, and 25.

Application Serial No. 09/892,727
Attorney Docket No. 60027.0018USU1/BS01040

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CONCLUSION

AUG 08 2006

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Final Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Final Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 13-2725.

Respectfully submitted,
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